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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,714	06/04/2001	Morenike Awokola	FA1002 US NA	4978

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EXAMINER

TSOY, ELENA

ART UNIT PAPER NUMBER

1762

DATE MAILED: 12/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

Office Action Summary	Application No. 09/873,714	Applicant(s) AWOKOLA ET AL.	
	Examiner Elena Tsoy	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 4, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9, line 3, a phrase "free-radically olefinic double bond" renders the claim

indefinite because the meaning of the phrase is not clear. For examining purposes the phrase was interpreted as -- free-radically polymerizable olefinic double bond -- or -- olefinic double bond --

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. **Claims 1-3, 5, 11, 12** are rejected under 35 U.S.C. 102(e) as being anticipated by

Anderson et al (US 6,387,519).

Anderson et al disclose a method for multilayer coating of substrates (See column 43, lines 21-37) which comprises applying a basecoat layer of a filler coating composition to a substrate (See column 18, lines 49-66; column 19, lines 1-7; column 43, lines 7-20; column 46,

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lines 22-25), curing the basecoat layer (See column 44, lines 29-30) by irradiation with high energy radiation (See column 21, lines 17-25; column 32, lines 17-32), and applying a topcoat layer to the cured basecoat layer and curing the topcoat layer (See column 43, lines 10-11; column 44, lines 37-50); wherein basecoat and topcoat filler coating compositions can be the same (See column 46, lines 22-30) and comprise: (A) polysiloxane (I) having R^2 = vinyl groups capable of free-radical polymerization, and (B) polysiloxane (I) having R^2 = unsaturated ester group such as methacrylate (ester of alpha,beta-olefinically unsaturated monocarboxylic acids

capable of free-radical polymerization having one double bond per molecule) column 18, line 57; column 19, lines 60-61, 66-67; column 21, lines 17-25) or optionally at least one film forming acrylic polymer (See column 28, lines 52-60) such as alkyl acrylates (See column 29, lines 6-24); and (C) compound having at least one *acid* phosphates (phosphoric acid group) (See column 40, lines 46-55).

As to claim 2, the topcoat layer comprises a colored basecoat and a transparent clear coat coating composition applied over the basecoat layer (See column 43, lines 10-11; column 46, lines 22-30).

As to claim 3, the topcoat layer comprises a pigmented one-layer topcoat (See column 43, lines 9-11; column 46, lines 22-26).

As to claim 5, the amount of the compound having *acid* phosphates in the topcoat filler composition is 0.1-5.0 wt % based on total weight of resin solids (See column 41, lines 2-9).

Considering the fact that the topcoat filler composition can be in the form of a powder coating composition (See column 40, lines 19-23) or in the form of 40-75 % solvent based composition (See column 40, lines 31-45), the amount of the compound having *acid* phosphates based on

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total quantity of the topcoat filler composition is in the range from 0.1-5.0 wt % to 0.25-12.5 wt %.

As to claim 11, Anderson et al further teach that the filler coating composition can be applied to polymeric coatings on substrates to revitalize (repair) them (See column 4, lines 18-23).

As to claim 12, a process is used in automobile coatings (See column 42, lines 8-21, 44-67).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4, 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,387,519).

Anderson et al, as applied above, further teach that the filler coating composition comprises 0.01-90 wt % of component (A) (See column 23, lines 57-64). However, Anderson et al fail to teach that the filler coating composition comprises 20-90 wt% of (B) (Claim 4); (A) comprises 1.5-2.5 double bonds per molecule (Claim 6).

It is held that concentration limitations are obvious absent a showing of criticality. *Akzo v. E.I. du Pont de Nemours* 1 USPQ 2d 1704 (Fed. Cir. 1987).

Furthermore, it is well known in the art that properties of a coating composition depend on concentration of components. In other words, concentration limitations are result-effective parameters in a coating process.

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It is held that it is not inventive to discover the optimum or workable ranges of result-effective variables by routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have discovered the optimum or workable ranges concentration of (A) and (B) (including those of claims 4 and 6) in a filler coating composition of Anderson et al by routine experimentation in the absence of showing criticality since general conditions are taught by

Anderson et al.

7. **Claims 7, 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,387,519) in view of Harris et al (US 5,596,043).

Anderson et al, as applied above, further teach that the filler coating composition for the use in automotive coatings may further comprise acrylic polymers having functionalities reactive toward functional groups of other components, and a curing agent (See column 28, lines 52-60); the acrylic polymers being prepared from alkyl methacrylates (See column 29, lines 6-24).

However, Anderson et al fail to teach that the acrylic polymers can be prepared from methacrylates of cycloaliphatic alcohols (Claim 7) such as isobornyl methacrylate (Claim 8).

Harris et al teach that acrylic polymers suitable for the use in automotive coatings (See column 1, lines 18-20) and comprising functionalities reactive toward functional groups of a curing agent can be prepared from either alkyl methacrylates or methcycloalkyl acrylates (See column 2, lines 57-65) such as isobornyl methacrylate (See column 3, lines 18-19).

It is held that the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in Sinclair & Carroll Co. v. Interchemical

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Corp., 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious); *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used methacrylates of cycloaliphatic alcohols such as isobornyl methacrylate for preparing acrylic polymers of Anderson et al for the use in automotive coatings and having functionalities reactive toward functional groups of other components and a curing agent since Harris et al teach that either alkyl methacrylates or cycloalkyl methacrylates such as isobornyl methacrylate acrylic are suitable for making acrylic polymers comprising functionalities reactive toward functional groups of a curing agent for the use in automotive coatings.

8. **Claims 9, 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al (US 6,387,519) in view of Richard (US 5,091,211).

Anderson et al, as applied above, fail to teach that the radiation curable filler coating composition comprises a compound having phosphoric acid group and a double bond (Claim 9) such as methacryloyl-modified phosphoric acid derivative (Claim 10).

Richard teaches that addition of a compound having phosphoric acid group and a double bond such as methacryloyl-modified phosphoric acid derivative (See column 2, lines 10-15, 37) to a radiation curable coating composition improves adhesion bond of the coating to a plastic substrate (See column 1, lines 57-60, column 2, lines 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified a radiation curable filler coating composition of Anderson et al by

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adding a compound having phosphoric acid group and a double bond such as methacryloyl-modified phosphoric acid derivative with the expectation of providing the filler coating composition with the desired improvement of adhesive properties of the composition toward plastic substrates, as taught by Richard.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (703) 605-1171. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elena Tsoy

Elena Tsoy
Examiner
Art Unit 1762

December 24, 2002